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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,248

07/20/2006

Mimi Adachi

64517.000003

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12/20/2011

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EXAMINER

SGAGIAS, MAGDALENE K

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

12/20/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MIMI ADACHI, KEIICHI NAKAYAMA,  
SHIGETAKA KITAJIMA, and HIROMITSU TAKAGI

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Appeal 2010-007915  
Application 10/580,248  
Technology Center 1600

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Before TONI R. SCHEINER, DONALD E. ADAMS, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request a rehearing under 37 C.F.R. § 41.52(a)(1) of the Board's decision entered September 14, 2011 (Decision) affirming the rejections of claims 1, 4-12, 15, 16, 31, 34, and 35 as obvious under 35 U.S.C. § 103(a). The request for rehearing is granted-in-part.

Appellants contend that "[t]he Board misapprehended Appellants' evidence of unexpected results" (Reg. Reh'g 2 (emphasis removed)). In support of this contention Appellants' representative introduces arguments

based on a table, which is new to this record (*id.* at 3). The newly introduced table reports data that Appellants' representative derives from Figure 8 of Appellants' Specification (*id.*). We deny Appellants' request for rehearing as it relates to Appellants' newly introduced table and the contentions based thereupon.

Appellants contend that the Board's rationale constitutes a new ground of rejection (*id.* at 5). Upon review of the analysis in the Decision and the Examiner's Answer, we agree with Appellants' contention that our analysis differs from the Examiner's and properly constitutes a new ground of rejection. Accordingly, we grant Appellants' request for rehearing on this issue and modify the Decision as follows:

- (a) The rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over the combination of Tamamori-Adachi, Sutterlüty, Sherr, Flink, and Poolman is affirmed. Because they are not separately argued claims 4-12, 15, 16, and 31 fall together with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).
- (b) The rejection of claim 34 under 35 U.S.C. § 103(a) as unpatentable over the combination of Tamamori-Adachi, Sutterlüty, Sherr, Flink, Poolman, and Carrano is affirmed. Because it is not separately argued claim 35 falls together with claim 34. 37 C.F.R. § 41.37(c)(1)(vii).

Because our rationale for affirming the foregoing rejections (a) and (b) is based on a rationale that differs from the Examiner's, we designate our affirmance a new ground of rejection.

- (c) The rejection of claims 17-25 under 35 U.S.C § 103(a) as unpatentable over the combination of Tamamori-Adachi, Sutterlüty, Sherr, Flink, and Poolman is reversed.

#### TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

GRANTED-IN-PART

cdc